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09/997,170	11/30/2001	Mark R. Baldock	BAI525-590/01918	7383

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EXAMINER

KOSTAK, VICTOR R

ART UNIT PAPER NUMBER

2614

DATE MAILED: 05/10/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/997,170

Applicant(s)

BALDOCK, MARK R.

Examiner

Victor R. Kostak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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1. The drawings are objected to because all block elements must be functionally labeled in compliance with rules 83(a) and 84(o). Regarding another matter, all features recited in the claims must be shown (such as by a flow chart or block diagram) in compliance with rule 83(a). Applicant's drawings do not account for all of the possible conditions specified in the claims.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The language should be clear and concise and should not repeat information given in the title. *It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.*

3. Claims are objected to because claims must start with the phrase "I" or "We claim ..."  
(see MPEP 608.01(m)). Appropriate correction is required.

4. Claim 13 provides for the use of controlling plural tuners, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. *A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.* Claims 13 and 14 read more like apparatus claims, similar to claims 1-12.

Claims 13 and 14 are accordingly is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper

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definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). See also *Ex parte Erlich*, 3USPQ2d 1011 at 1017).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3 and 5-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Shendar.

The system of Shendar (noting particularly Fig. 1) involves arranging plural tuners (1 – 3) that can receive digital television programming (e.g. col. 1 lines 42-44) independent of one another (evident, at least, by element 22), and all at known RF frequencies (such being set by communication standards). When a viewer selects a first channel on a first tuner (e.g. tuner 1), a second available tuner can receive another channel based on a predictive action by control element 22 (e.g. col. 2 lines 19-24), thereby meeting claims 1 and 13.

As for claim 3, a different channel (i.e. that represented by a different RF frequency) is selected for tuning by the other tuner (noting again col. 2 lines 19-24).

As for claim 5, the first tuner accordingly reproduces the selected program transmitted on the first channel for presentation on display 20 (with typically accompanying audio signals), and

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the other tuner can be tuned to another channel for storage (col. 3 lines 4-5). If the second channel is not set for recording, it can be in the prediction mode, as discussed above.

As for claims 6 and 7, the predictions can be based on previous selection patterns (e.g. favorite channels: col. 3 lines 41-43), which is stored (col. 3 lines 43-47).

Regarding claim 8, generic data provided by the broadcasters can also be used for predicting channel changing is covered by the favorite channel listing, discussed above, or by checking repetitive behavior (col. 3 lines 32-40).

As for claim 9, the system of Shendar operates in a manner where when the user eventually selects a predicted channel for presenting the desired program, that selected channel is obtained from the other tuner that identified that channel as the predicted channel (Col. 2 line 25+).

Considering claim 10, when the second tuner identifies a predicted channel, it can tune into that carrier frequency (noting again col. 2 line 25+).

As for claim 11, the multiple tuner system of Shendar does not have to be continuously used in the channel predicting mode, such as when a new selection is manually selected or when a tuner is dedicated (col. 3 lines 1-15).

As for claim 12, more than one secondary tuner can be used for tuning into predicted channels (noting Figs. 1 and 2, for example).

As for claim 14, the pattern detection and channel storage as a result thereof is covered by the profiling of Shendar (col. 3 lines 32-47), the ultimate display selection being based thereon.

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shendar.

It would have been obvious to one of ordinary skill in the art to tune to the same channel by separate tuners using suitable selection functions by element 22 through controller 24 (instead of continuously running automatic operations), for the clear purpose of determining which tuner reproduces the desired programming in the best form, thereafter tuning specifically to that tuner, thereby meeting claim 2.

As for claim 4, since each tuner can receive any signal on any assigned band, operating as fully competent units (thereby covering all channels including predicted channels), it would have been obvious to ignore a prediction such as when receiving a channel already desired (such as a favorite channel). Any subsequent channel changing could then be carried out using any of the prediction operations covered by Shendar.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should note that the additional references are also relevant to the claims as they all teach using multiple tuners to enable faster switching, using tuning prediction data.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is 703 305-4374. The examiner can normally be reached on Monday - Friday from 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

**(703) 872-9306 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 308-HELP.

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Victor R. Kostak  
Primary Examiner  
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VRK

